

REMARKS

This paper is responsive to an Office Action mailed March 3, 2009. Prior to this response, claims 1-47 were pending. After amending claims 1, 14, 24, 37, and 47 and canceling claims 4-5, 8, 17, 27-28, 31, and 40, claims 1-3, 6-7, 9-16, 18-26, 29-30, 32-39, and 41-47 remain pending.

In Section 3 of the Office Action claims 1-23 have been rejected under 35 U.S.C. 101 for not falling within one of the four statutory categories of invention. In response, claim 1 has been amended to recite a receiver system with a decoder and a display. Claim 14 has been amended to recite a transmitter system with an encoder. Claims 1 and 14 are now tied to the statutory category of an apparatus. Further, claims 1 and 14 now both recite a transformation of the underlying subject matter. As is well known to those practicing in the art, the signals recited in claims 1 and 14 must necessarily be communicated as electromagnetic waveforms. Electromagnetic waveforms are dependent upon the conduction of electrons, which are particles having a mass. Therefore, the transformation of a received electromagnetic waveform describes the transformation of the underlying subject matter at the most basic level. Since claims 1-23 fall within at least two of the four statutory categories under 35 U.S.C. 101, the Applicant requests that the rejection be removed.

In Section 3 of the Office Action, claims 1, 2, 9-12, 14-17, 20-25, 32-35, 37-40 and 43-47 have been rejected under 35 U.S.C. 102(b) as anticipated by Urano et al. ("Urano"; US 5,767,898). The Office Action states that Urano discloses all the limitations of claims 1, 14, 24, 37, and 47. This rejection is traversed as follows.

Claim 1 has been amended to include the subject matter of claim 4. This subject matter of claim 4 was not found to be anticipated by Urano. As a result, claim 1, and all claims dependent from claim should no longer be found anticipated by Urano.

Claims 17, 27, and 40 include subject matter similar to claim 4. With respect to claim 17, the Office Action states that Urano disclose SEI 3D option messages that trigger optional single field 2D decoding, citing Fig. 8. The Applicant respectfully disagrees as neither Fig. 8, nor the explanation of Fig. 8 describes the limitation of optional single field 2D decoding. In fact, Urano's only mention of the term "two-dimensional" occurs in the non-analogous discussion of inter-frame prediction and parallax compensation of a merged (i.e. 3D) image (col. 15-16). This same analysis holds also holds true for claims 27 and 40. Claims 24 and 37 have been amended to include the subject matter of claims 27 and 40, respectively. Further, claim 47 has been amended to include similar subject matter. Since claims 14, 24, 37, and 47 recite subject matter that is not explicated shown or described by Urano, these claims cannot be anticipated. Likewise, all claims dependent from claims 14, 24, or 37 should be found to be unanticipated by Urano, and the Applicant requests that the rejection be removed.

In Section 5 of the Office Action claims 3-8, 13, 18-19, 26-31, 36, and 41-42 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Urano in view of Swift et al. ("Swift"; US 2002/0122585). With respect to claims 4, the Office Action acknowledges that Urano fails to disclose an SEI option message to trigger the decoding of only one of the two fields (for 2D viewing), but that Swift discloses decoding only one field for 2D viewing. The Office Action states that the motivation to modify the teachings

of Urano with Swift would have been to enable viewing. This rejection is traversed as follows.

As noted above, independent claims 1, 14, 24, 37, and 47 have been amended to include subject matter similar to claim 4 as originally filed. Therefore, in responding to the obviousness rejection, the Applicant is primarily addressing the rejection of claim 4.

As noted above, and as acknowledged in the Office Action in the rejection of claim 4, Urano does not disclose the transmission or reception of an SEI 3D content message, for signaling a receiver to decode only a single field of a frame of interlaced field, if the display is only capable of presenting a 2D image.

Swift discloses a stereoscopic media format with independent right and left channels, which supports monoscopic (2D) viewing [0006]. Swift's only other discussion of converting 3D media to 2D viewing occurs in paragraphs [0045-0046], as follows:

[0045] Monoscopic and Stereoscopic Viewing allows greater distribution since both types can be viewed within one system. Prior Electronic Stereoscopic viewing systems only display stereoscopic media. The embodiments of the invention accommodate monoscopic and stereoscopic viewing. The embodiments of the invention allow users to access stereoscopic media without a 3D stereoscopic enabled physical viewing device. This invention can have greater distribution and market penetration since it is not dependent upon a physical viewing device. This viewing system can be toggled to display monoscopic, as well as various stereoscopic modes (color anaglyph, gray anaglyph, line interleaved, page-flipping, cross-eye, parallel viewing, etc.). In monoscopic mode, the image appears in 2D like other 2D web based images which allows all web users to view the images in 2D even if they do not have a

stereoscopic viewing device.

[0046] This is accomplished by showing either the left or right mono image. The user can select whether to view the left or right monoscopic view. Users without a physical stereo viewing device can see the media in monoscopic form by selecting to use either the right or left monoscopic views.

Swift describes monoscopic and 2D viewing. However, he gives no specifics as to how the stereoscopic media is decoded to support 2D viewing. With respect to 3D imaging, Swift discloses a means to code multiple views independently [0061-0062]. However, Swift does not disclose a means of coding multiple views in an *interleaved* format. Swift clearly states that that left and right images are encoded and compressed independently (not interleaved). Thus, Swift does not disclose a means of independently coding fields when they are in an interleaved format, as recited in the claimed invention. It can also be concluded that Swift (as well as Urano) fails to disclose a means of both dependently (3D) and independently (2D) coding fields in a row interleaved format.

The Office Action states that Swift discloses: 1) analyzing display capabilities; 2) decoding only one of the video frame interface fields if the display is not stereoscopic; and, presenting a 2D image.

In traverse, the Applicant can find no evidence that Swift performs an analysis of an SEI 3D content message, or any kind of meta-data, that causes a receiver to decode only a single field in a frame of interlaced fields. Rather, Swift merely mentions that the system can be toggled to display monoscopic views [0045]. More important, Swift does not disclose interlacing fields. Therefore, Swift cannot disclose the narrower limitation of decoding a single field from a frame of interlaced fields.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, the *KSR International Co. v Teleflex Inc.* decision (82 USPQ2d 1385, 1395-1397, 2007) suggests 7 exemplary rationales to support a conclusion of obviousness, which include:

A) Combining prior art elements according to known methods to yield predictable results;

B) Simple substitution of one known element for another to obtain predictable results;

C) Use of known technique to improve similar devices (methods, or products) in the same way;

D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

E) "Obvious to try" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

G) Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

The Office Action states that modifications to Urano would have been obvious to one of ordinary skill in the art in light of Swift. This rejection appears to be most closely grounded in the G) rationale - Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to

modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

With respect to this rationale, MPEP 2143 (G) states that the rejection must articulate the following criteria to resolve the *Graham* factual analysis:

(1) a finding that there was some teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings;

(2) a finding that there was a reasonable expectation of success; and

(3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

With respect to the above-referenced first factual analysis criteria, the Swift reference has been combined with Urano based upon the assumption that the combination discloses every limitation recited in Applicant's claim 4. However as acknowledged in the Office Action, Urano does not disclose the use of REI 3D content messages that cause a receiver to decode only a single field in a frame of interlaced fields, if non-3D capabilities are detected. Further as noted above, Swift discloses no message analysis and no interlaced fields. Therefore, it would not be possible for Swift to decode a single field of interlaced data. As a result, even if elements from Swift are combined with Urano, the combination does not explicitly disclose every limitation of amended claim 1. Claims 3, 7-8, and 13, dependent from claim 1, enjoy the same advantages. Amended claims 24 and 47 include

essentially the same limitations as claim 1 and, therefore, can be distinguished from the prior art for the same reasons. Likewise, claims 26, 29-30, and 36, dependent from claim 24, enjoy the same advantages.

Claims 14 and 37 recite the limitations of an encoder transmitting an SEI 3D option message with a video frame of interlaced fields, to trigger optional single field 2D decoding. As noted above, neither Urano nor Swift discloses such a message or triggering mechanism. Therefore claims 18-19, dependent from claim 14, and claims 41-42, dependent from claim 37, can be distinguished from the prior art.

In the rejection of claim 4, the Office Action states that it would have been obvious to modify Urano in light of Swift in order to display 3D data, with the motivation being to enable viewing. However, the desire to enable viewing does not suggest a means of decoding a single field from a frame of interlaced fields. Alternately stated, since Swift does not use interlaced fields, there can be no suggestion that Swift discloses a means of modifying Urano in such a manner as to permit only a single field to be decoded when the frame is composed of interlaced fields.

Neither has any evidence been provided that such a modification would have been obvious to one with skill in the art based upon what was well known at the time of the invention. "(A)nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). However, if the *prima facie* rejection is supported by what was known by a person of ordinary skill in the

art then additional evidence should have been provided. Notable, when the source or motivation is not from the prior art references, “the evidence” of motive will likely consist of an explanation or a well-known principle or problem-solving strategy to be applied”. *DyStar*, 464 F.3d at 1366, 80 USPQ2d at 1649.

The only principle or problem-solving strategy mentioned in the Office Action is to “enable viewing”. The Office Action does not supply evidence that it was well known at the time of the invention to send SEI 3D content messages to trigger 2D decoding if non-3D capabilities are detected. Neither does the Office Action supply evidence that it was well known at the time of the invention to decode only a single field from a frame of interlaced fields.

A *prima facie* analysis of motivation is especially since the rejection is predicated on limitations that are not explicitly disclosed in the prior art references. The claimed invention can only be obvious if an artisan makes substantial modifications to the Urano. However, there is nothing in the Swift reference that suggests a modification. Further, no evidence has been provided that such a modification would have been obvious based upon well known principles.

With respect to the second analysis criteria needed to support the G) obviousness rationale, even if a practitioner were given the Urano and Swift references as a foundation, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention. That is, there can be no reasonable expectation of success if the references, and what was known by artisan at the time of the invention, do not teach all the limitations of the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of Urano and Swift does not explicitly disclose every limitation of claims 1, 14, 24, 37, and 47. Neither has a case been supported that Urano can be modified to supply the missing limitations in view of Swift, or what was well known by a person of skill at the time of the invention. Therefore, the Applicant requests that the rejection of claims 1-3, 6-7, 9-16, 18-26, 29-30, 32-39, and 41-47 be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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